



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,479	07/09/2001	L. Carlton Brown JR.	006969-022311US	7465

20350 7590 02/08/2005

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

COSIMANO, EDWARD R

ART UNIT PAPER NUMBER

3629

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,479

Applicant(s)

BROWN ET AL

Examiner

Edward R. Cosimano

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>see attached</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3629

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 119(e) and 35 U.S.C. § 120 is acknowledged.
3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).
4. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".
- 4.1 Claims 22-24 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.
- 4.1.1 The instant claims recite a system/device/manufacture, (claims 22-24), which has a disclosed practical application in the technological or useful arts, and which does not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon. Hence, the instant claims merely define device/manufacture that contains a data structure comprising series of steps or acts or functions or operations that as claimed could be but are not necessarily to be performed by a computer.
- 4.1.2 It is further noted that applicant has not recited a specific machine since the steps or acts or functions or operations recited in the claim are merely to illustrate the steps or acts or functions or operations of the instant invention since these steps or acts or functions or

Art Unit: 3629

operations as claimed are not in fact implemented by a processor/computer. Hence, applicant envisions the invention as recited in claims 22-24 as a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure. Such a disembodied storage device is not a specific machine because:

A) it is not associated with a computer in such a way as to cause the computer to operate in a specific manner, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578); and

B) a memory device alone can not perform the functions recited within the claims.

Therefore, the recited disembodied storage device, which itself can not perform the functions recited within the claims as the invention, is inoperative and lacks utility for the purpose of the invention.

4.1.3 In view of the above, the invention recited in claims 22-24, merely describes an abstract idea of a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure, since a disembodied storage device by itself can not produce a concrete and tangible result by performing the functions recited within the claims as the invention (State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)). Hence, claims 22-24 does not have a claimed practical application, since the disembodied storage device is inoperative and therefore lacks utility for the purpose of the invention.

4.1.4 Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium;

Art Unit: 3629

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

4.1.5 Hence, claims 22-24 are directed to non-statutory subject matter.

5.2 Claims 1-32 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since:

- A) in regard to claims 1-32, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 103 as set forth below.

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- (c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6.1 Claims 1-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Whitehouse (6,005,945) or Heiden et al (6,141,645) or Brookner et al (WO 98/13790) or Shah et al (5,822,738) or Kara (5,822,739) or Gravell et al (WO 98/57303) or Lee et al (EP 0927960) or Brasington et al (5,923,406) or Sansone (5,978,781) or Shah et al (2003/0078893)

Art Unit: 3629

or Beckstrom et al (6,594,374) or Bator et al (6,619,544) in view of applicant's admitted state of the art.

6.1.1 In regard to claims 1-9, 12-22 & 25-28, either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) or Bator et al ('544), in the environment of computerized postage metering systems discloses a secured metering device (SMD) that has been licensed by the Postal Authority to store and dispenses postage and is used by a postage vendor to dispense postage to customers of the vendor. When a customer, that is located remotely from the SMD, at the customer's general purpose PC or a kiosk desires to print postage on an item of mail using the a general purpose printer, then the user at the PC/kiosk would create a request for postage. Where the request for postage would include customizable constraints, for example, at least an identification of the customer, the originating location, the postage value, class of service or DTD, destination zip code, piece count or transaction identifier, an indication of the method of payment, as well as any other information required to determine the correct postage for an item of mail. Next, the generated request for postage is formed into a communication message/packet and transmitted to remotely located SMD via a suitable network interface and communications network. Once at the SMD the transmitted information is used to:

A) validate the request and whether there are sufficient funds for the requested postage value to be printed;

B) account for the requested postage in a single general account or an individual account for the user; and

C) to generate a print file of a valid postage indicia that includes encode information as evidence of postage payment.

The print file is then transmitted back to the identified user at the PC via a suitable communications network where the postage is printed with suitable security features on either the item of mail or a label to be applied to the item of mail by the user using the general purpose printer. The above process is repeated for each user at a PC/kiosk that is requesting to print postage on an item of mail.

Art Unit: 3629

6.1.2 Neither Brookner et al ('790) nor Shah et al ('738) nor Kara ('739) nor Gravell et al ('303) nor Lee et al ('960) nor Brasington et al ('406) nor Sansone ('781) nor Whitehouse ('945) nor Heiden et al ('645) nor Shah et al ('893) nor Beckstrom et al ('374) nor Bator et al ('544) disclose the use of a mark-up language, however, either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) or Bator et al ('544) require the use of a communications network, for example the internet. Since as disclosed by applicant:

A) XML, HTML and SGML are equivalent mark up languages, see the paragraph located between page 5, line 31, and page 6, line 9, "The present invention ... features. The markup language includes, for example, one or more of the following: the eXtensible Markup Language (XML); the Hypertext Markup Language (HTML) or the Standard Generalized Markup Language (SGML).";

B) in the environment of the internet, it is known that web pages may be written in HTML, see the paragraph located between page 9, line 21, and page 10, line 2, "As stated above, a user may use ... web pages may be written in Hypertext Markup Language (HTMQ and may incorporate any combination of text, graphics, audio and video content, software programs, and other data. Web pages may also contain hypertext links to other web pages. Each ... downloaded web page may then be viewed by the user using the browser.";

it would have been obvious to one of ordinary skill at the time of the invention, that the postage vending systems of either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) or Bator et al ('544) would use a communications protocol, language and control protocol that is suitable for the communications link being used, that is if the link is the internet, then either XML or HTML or SGML would be used.

7. The examiner has cited prior art of interest, for example:

Art Unit: 3629

A) Abumehdi (5,508,933) which discloses the process following by accounting units in postage metering systems.

B) Bransten which discloses dispensing postage over the internet.

C) Carroll et al (6,470,327) which discloses a web based postage dispensing system.

8. The examiner has considered the prior art cited in the parent and the IDSs filed 09 July 2001 & 16 October 2002

9. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

10.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

10.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

10.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

02/07/05



Edward R. Cosimano
Primary Examiner A.U. 3629